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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
	:	
Erik BURCKART, et al.	:	Confirmation Number: 6713
	:	
Application No.: 10/717,007	:	Group Art Unit: 2194
	:	
Filed: November 19, 2003	:	Examiner: V. Nguyen
	:	

For: UNOBTRUSIVE PORT AND PROTOCOL SHARING AMONG SERVER
      PROCESSES

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

     This Appeal Brief is submitted in support of the Notice of Appeal filed December 20,

2007, wherein Appellants appeal from the Examiner's rejection of claims 1-20.

I. REAL PARTY IN INTEREST

     This application is assigned to IBM Corporation by assignment recorded on July 13,

2004, at Reel 015554, Frame 0860.

II. RELATED APPEALS AND INTERFERENCES

     Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-20 are pending and two-times rejected in this Application. It is from the multiple rejections of claims 1-20 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Second and Final Office Action dated September 20, 2007 (hereinafter the Second Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

1   Referring to Fig.1 and also to independent claim 1, a system for port and protocol sharing

2   is disclosed. The system includes a layered hierarchy of application processes 150, 155, 165 and

3   protocols 140, 175 (lines 6-12 of paragraph [0021], an interlayer communications process, and a

4   communication layer 130. The interlayer communications process 135, 145, 170 is disposed

5   between each layer in the layered hierarchy (lines 8-11 of paragraph [0020]). The

6   communications layer 130 is programmed to moderate access by all of the application processes

7   150, 155, 165 and protocols 140, 175 in the layered hierarchy to a single logical port 125 (lines

8   4-9 of paragraph [0020]).

9   Referring to Figs. 1 and 2 and also to independent claim 1. 7 and 14, in a hierarchy of

10   layered applications and corresponding protocols, a port and protocol sharing method and

11   machine readable storage for executing the method is disclosed. Traffic is received over a single

12   shared logical port 125 and the traffic is routed to an interlayer communications process 135,

13   145, 170 disposed between two layers in the hierarchy (lines 8-11 of paragraph [0020]). A

14   particular application/protocol layer is selected in a higher one of the two layers to which the

1   traffic is to be routed, and the traffic is routed to the selected particular application/protocol layer

2   (lines 4-6 of paragraph [0009]).

3   Referring to Figs. 2 and 3 and also to independent claims 11 and 18, a method for

4   augmenting a hierarchy of layered applications and corresponding protocols and machine

5   readable storage for executing the method is disclosed. A discrimination algorithm 220 is

6   applied to a selection process in which a particular application/protocol layer 230 in a listing 250

7   of adjacent application/protocol layers 230A, 230B is selected to receive traffic flowing through

8   the hierarchy (lines 4-7 of paragraph [0028]). In block 310, a new application/protocol layer

9   230C is inserted adjacent to the particular application/protocol layer 230B in the hierarchy (lines

10   5-8 of paragraph [0031]). In block 330, the new application/protocol layer 230C to added the

11   listing 250 (lines 3-6 of paragraph [0031]). In block 340, the discrimination algorithm 220 is

12   replaced with another discrimination algorithm programmed to consider the new

13   application/protocol layer 230C during the selection process (lines 6-11 of paragraph [0032]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 14-20 were rejected under the second paragraph of 35 U.S.C. § 112;

2. Claims 1-6 were rejected under 35 U.S.C. § 101; and

3. Claims 1-20 were rejected under 35 U.S.C. § 102 for anticipation based upon Gase, U.S. Patent No. 6,363,081.

VII. ARGUMENT

1   THE REJECTION OF CLAIMS 14-20 UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

2   For convenience of the Honorable Board in addressing the rejections, claims 15-20 stand

3   or fall together with independent claim 14.

4

5   On page 2 of the Second Office Action, the Examiner newly rejected claims 14-20 under

6   the second paragraph of 35 U.S.C. § 112 while arguing "[a]s to claims 14 and 18, *'the machine'*

7   lacks antecedent basis" (emphasis in original). In response, Appellants respectfully submit that

8   the Examiner has failed to establish a prima facie case of indefiniteness under the second

9   paragraph of 35 U.S.C. § 112. M.P.E.P. § 2173.02 states the following:

10   If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C.
11   112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why
12   the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action.
13   (emphasis added).
14
15   As stated in <u>Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings</u>,[1] "[o]nly when a claim

16   remains insolubly ambiguous without a discernible meaning after all reasonable attempts at

17   construction must a court declare it indefinite." The Examiner, however, has not established an

18   interpretation of the claim in light of the specification or an interpretation of the claim as

19   interpreted by one of ordinary skill in the art. Moreover, the Examiner has failed to set forth any

20   analysis as to why the limitation(s) in the claim does not reasonably define the invention.

21

22   Notwithstanding the Examiner's lack of analysis, independent claim 14 recites "machine

23   readable storage (i.e., storage readable by a machine), and Appellants' respectfully submits that

24   one having ordinary skill in the art would interpret "the machine" as referring to the machine that

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1 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

1   reads the storage. Thus, Appellants' position is that one having ordinary skill in the art would

2   have no difficulty understanding the scope of claims 14-20, particularly when reasonably

3   interpreted in light of the written description of the specification.[2]

4

5   **THE REJECTION OF CLAIMS 1-6 UNDER 35 U.S.C. § 101**

6   For convenience of the Honorable Board in addressing the rejections, claims 2-6 stand or

7   fall together with independent claim 1.

8

9   On pages 2-7 of the Request for Reconsideration filed July 2, 2007 (hereinafter the

10   Response), Appellants presented extensive arguments in response to the Examiner's rejection of

11   claims 1-13 under 35 U.S.C. § 101 (these arguments are incorporated herein by reference). With

12   regard to these arguments the Examiner asserted on page 11 of the Second Office Action that

13   "Applicants' arguments have been fully considered but are moot in view of the new ground(s)

14   rejection." This statement, however, is inaccurate.

15

16   The paragraph spanning pages 4 and 5 of the Second Office Action is identical to the first

17   full paragraph on page 3 of the First Office Action. Specifically, the Examiner asserted:

18   Claims which are broad enough to read on statutory subject matter or on non-statutory subject
19   matter are considered non-statutory. Cf. In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562
20   (CCPA 1972) ("Claims which are broad enough to read on obvious subject matter are
21   unpatentable even though they also read on nonobvious subject matter.") During prosecution,
22   applicant can amend to limit the claims to statutory subject matter.
23

24   In response to this paragraph, Appellants presented the following arguments in the Response.

25   Appellants' position is that the Examiner has inappropriately applied the holding of In re Lintner.

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[2] In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

1   This case was directed to determining whether the claims were broad enough to encompass

2   subject matter that qualified as prior art under 35 U.S.C. § 103.

3

4   Even if the claims could be construed to cover non-statutory subject matter, this fact

5   alone is not dispositive with regard to a rejection under 35 U.S.C. § 101. The entire text of § 101

6   is reproduced below:

7   Whoever invents or discovers any new and useful process, machine,

8   manufacture, or composition of matter, or any new and useful improvement

9   thereof, may obtain a patent therefor, subject to the conditions and requirements

10   of this title.

11

12   In comparison, 35 U.S.C. § 102[3] which states "[a] person shall be entitled to a patent <u>unless</u> ..."

13   (emphasis added). The difference between § 101 and § 102 of 35 U.S.C. is that 35 U.S.C. § 102

14   states that if the claims cover certain subject mater (i.e., anticipatory prior art), then the inventor

15   shall not be entitled to a patent. On the contrary, whereas the existence of a single piece of

16   anticipatory prior art excludes a patent from granting under § 102, <u>§ 101 is not similarly written</u>.

17   Instead, 35 U.S.C. § 101 only requires that the claimed invention cover statutory subject matter

18   and does not explicitly prevent a patent from issuing if the claimed invention also covers non-

19   statutory subject matter.

20

21   The logic behind this notion is best illustrated by considering the consequences if the

22   Examiner's legal assertion was, in fact, correct. It is well-established that a non-functional (i.e.,

23   inoperable) device is non-statutory, and the Patent Office has determined that utility, for

---

[3] Section 103 of 35 U.S.C. qualifies prior art using 35 U.S.C. § 102.

1   example, as landfill or as a paperweight, does not meet the utility requirements of 35 U.S.C. §

2   101. Thus, an inoperable device would be considered to be non-statutory subject matter.[4]

3

4   Most patentable claims, however, cover inoperable devices and, thus, non-statutory

5   subject matter. For example, few claims that cover a computer actually recite a power source,

6   but a computer is inoperable without a power source. These claims, nevertheless, cover non-

7   operable computers that do not include power sources.

8

9   Similarly, few claims recite all the features necessary to make a particular invention

10   operable. Therefore, it is readily apparent that nearly all claims are capable of covering subject

11   matter, which defined solely by the claims, could be considered non-statutory subject matter.

12   Thus, if the Examiner's legal assertion was correct, then most claims would be rejected under 35

13   U.S.C. § 101. Since the Examiner's proposed "test" is clearly not being employed by the Patent

14   Office, the test as to whether or not a claim satisfies the requirement of 35 U.S.C. § 101 does not

15   involve determining whether or not a claim could cover some subject matter that is deemed non-

16   statutory involves. Instead, the test involves determining whether the claim covers some

17   statutory subject matter.

18

---

[4] See M.P.E.P. § 2107.01(II):

An invention that is "inoperative" (i.e., it does not operate to produce the results claimed by the patent applicant) is not a "useful" invention in the meaning of the patent law. See, e.g., Newman v. Quigg, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); In re Harwood, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968) ("An inoperative invention, of course, does not satisfy the requirement of 35 U.S.C. 101 that an invention be useful.").

As already noted above, the Examiner did not directly respond to these arguments in the Second Office Action. Instead, the Examiner presented additional arguments on pages 3 and 4 of the Second Office Action. Initially, the Examiner asserted the following:

> Claims 7-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under a broadest reasonable interpretation, the method claims 7 and 11 are unpatentable under section 101 because (i) they do not qualify as a "process" under section 101, as that term has been interpreted by case law, (ii) they seek to patent an abstract idea, and (iii) the "useful, concrete, and tangible result" test does not apply here, but the claim nevertheless does not meet that test.

As will be described in greater detail below, the Examiner has _failed_ to give the claims their broadest reasonable interpretation consistent with Appellants' specification. As to the Examiner's item (iii), the Examiner has _failed_ to explain why the useful, concrete and tangible result test does not apply and _failed_ to explain why the claim does not meet that test. Instead, the Examiner's comments are conclusory without accompanying analysis.

The Examiner further asserted the following on pages 3 and 4 of the Second Office Action:

> The method claims 7 and 11 differ from traditional process claims in several respects. For example, the claims do not recite any particular way of implementing the steps, nor does they require any machine or apparatus to perform the steps. In addition, the method claims do not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Finally, the claims do not call for any physical transformation of an article to a different state or thing. While claim 7 does perform _receiving_, _selecting_, and _routing_; and claim 11 does perform a transformation of data by _inserting_, _adding_, _replacing_, they do not require any machine or apparatus to perform the steps. Because the claims are completely untethered from any sort of structure or physical step, they are directed to a disembodied concept. In other words, the claims are nothing but a disembodied abstract idea until it is instantiated in some physical way so as to be limited to a practical application of the idea. For example, claims 7 and 11 do not specify whether the entity performing the steps of _receiving_, _selecting_, and _routing_ (claim 7) and _applying_, _inserting_, _adding_, _replacing_ (claim 11) is a computer, a human, or something else.

In this regard, Appellants are still unclear as to the significant difference between claim 1 of the U.S. Patent No. 5,333,184 (hereinafter the '184 patent)[5] and claims 7-13 of the present

---

[5] As discussed on page 4 of the Response, the '184 patent was the subject of the decision by the Federal Circuit in AT&T Corp. v. Excel Communications, Inc.

1   application which leads to the conclusion that claims 7-13 of the present application are directed

2   to non-statutory subject matter, whereas claim 1 of the '184 patent is directed to statutory subject

3   matter. This question was initially presented on page 5 of the Response, yet the Examiner has

4   failed to respond.

5

6   Another good comparison is between claim 1 of the Examiner's cited reference of Gase

7   and claims 7-13 of the present application. Appellants are unaware of any substantial change in

8   the jurisprudence of 35 U.S.C. § 101 since the Gase issued in March of 2002.

9

10   Despite the Examiner's failure to distinguish between claim 1 of the '184 patent and

11   claims 7-13 of the present application, the Examiner's analysis is simply wrong. Appellants are

12   unclear as to how, e.g., "a shared logic port," "two layers in the hierarchy," and "routing" are not

13   tied to some sort of structure. Referring again to the Examiner's failure to give the claims their

14   broadest reasonable interpretation consistent with Appellants' specification, reference is made to

15   paragraph [0033] of Appellants' specification which states "the method and system of the present

16   invention can be realized in a centralized fashion in one computer system, or in a distributed

17   fashion where difference elements are spread across several interconnected computer systems."

18   Thus, under a broadest interpretation, the claimed method involves hardware.

19

20   Reference is also made to the recent decision of the Federal Circuit of In re Comiskey,[6]

21   which is directed to similar issues. Although the Court held that several claims were directed to

---

[6] Appeal No. 2006-1286.

1   non-statutory subject matter, the Court determined that other of the claims[7] were directed to

2   statutory subject matter. In determining the latter, the Court stated the following:

3   These claims, under the broadest reasonable interpretation, <u>could</u> require the use of a computer as
4   part of Comiskey's arbitration system. (emphasis added)
5
6   Thus, the Court determined that the claims are not required to necessarily recite a computer.

7   Instead, the Court concluded that if the claims, under a broadest reasonable interpretation, <u>could</u>

8   require the use of statutory subject matter (e.g., a computer, a device, a product, etc.), then the

9   claims meet the requirements of 35 U.S.C. § 101. Since the standard, as set forth by the Federal

10   Circuit, only requires that the claims could require statutory subject matter, and since under a

11   broadest reasonable claim construction, the claimed method could include hardware, claims 7-13

12   meet the requirements of 35 U.S.C. § 101.

13

14   The last of the Examiner's new assertions is found on page 4 of the Second Office Action

15   and reproduced below:

16   Accordingly, the claims are so broad that they are directed to the abstract idea itself, rather than a
17   practical implementation of the concept. In addition, the claims are "so abstract and sweeping" that
18   they would "wholly pre-empt" all applications (whether performed by a machine or a human) that
19   are directed to *augmenting a hierarchy of layered applications and corresponding protocols.*
20   (emphasis added)
21
22   Notwithstanding that the Examiner's statement is conclusory and <u>entirely factually unsupported,</u>

23   Appellants are unclear as to how the Examiner's alleged preemption of "augmenting a hierarchy

24   of layered applications and corresponding protocols" relates to the claimed methods.

25

26   Therefore, for the reasons stated above, Appellants submit that the imposed rejection of

27   claims 7-13 under 35 U.S.C. § 101 is not viable.

---

[7] ("We consider independent claims 17 and 46 separately. They recite the use of 'modules,' including 'a registration module for enrolling' a person, 'an arbitration module for incorporating arbitration language,' and 'an arbitration resolution module for requiring a complainant [or party] to submit a request for arbitration resolution to the mandatory arbitration system.'")

1

2 THE REJECTION OF CLAIMS 1-20 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED

3 UPON GASE

4   For convenience of the Honorable Board in addressing the rejections, claims 7, 9, 11-12,

5 14, 16, and 18-19 stand or fall together with independent claim 1; claims 10, 13, 17, and 20 stand

6 or fall together with claim 5; claims 8 and 15 stand or fall together with claim 2; and each of

7 claims 3-4 and 6 stands or fall alone.

8

9   As is evident from Appellants' previously-presented comments during prosecution of the

10 present Application and from Appellants' comments below, there are questions as to how the

11 limitations in the claims correspond to features in the applied prior art. In this regard, reference

12 is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the

13 following is stated:

14   (A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's
15 answer is <u>required to include</u>, under appropriate headings, in the order indicated, the following
16 items:
17   ...
18   (9)(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions
19   as to how limitations in the claims correspond to features in the prior art even after the
20   examiner complies with the requirements of paragraphs (c) and (d) of this section, the
21   examiner must compare at least one of the rejected claims feature by feature with the
22   prior art relied on in the rejection. The comparison must align the language of the claim
23   side-by-side with a reference to the specific page, line number, drawing reference
24   number, and quotation from the prior art, as appropriate. (emphasis added)
25
26 Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner's

27 Answer, the Examiner is required to include the aforementioned section in the Examiner's

28 Answer.

29

1   The factual determination of anticipation under 35 U.S.C. § 102 requires the <u>identical</u>

2   disclosure of <u>each</u> element of a claimed invention in a single reference.[8] As part of this analysis,

3   the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the

4   elements in light of the specification and prosecution history, and (c) identify corresponding

5   elements disclosed in the allegedly anticipating reference.[9] This burden has not been met.

6   Moreover, the Examiner has failed to clearly designate the teachings in Gase being relied upon

7   the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also

8   fails to comply with 37 C.F.R. § 1.104(c), which reads:

9   In rejecting claims for want of novelty or for obviousness, the examiner must cite the best
10   references at his or her command. When a reference is complex or shows or describes inventions
11   other than that claimed by the applicant, the particular part relied on must be designated as nearly
12   as practicable. The pertinence of each reference, if not apparent, must be clearly explained and
13   each rejected claim specified.
14

15   Despite these requirements, the Examiner's statement of the rejection simply consists of

16   the Examiner repeating, almost word-for-word, each of the recited claims and asserting that the

17   entire claim is disclosed by certain specified passages within Gase. The manner in which the

18   Examiner conveyed the statement of the rejection, however, has not "designated as nearly as

19   practicable" the <u>particular parts</u> in Gase being relied upon in the rejection.

20

21   It is <u>practicable</u> for the Examiner, for each of the claimed elements, to specifically

22   identify <u>each</u> feature within Gase being relied upon to teach each of the particular claimed

23   elements. For example, the Examiner can "specifically identify" a feature, corresponding to the

24   claimed element, within the applied prior art by identifying a reference numeral associated with

25   the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2

[8] <u>In re Rijckaert</u>, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); <u>Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.</u>, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).
[9] <u>Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.</u>, <u>supra</u>.

1   lines or even a portion of a line) within the applied prior art that identifies the feature that

2   corresponds to the claimed element. However, merely citing a long passage, an entire paragraph,

3   or several columns to disclose a single (or multiple) claimed elements does not designate "as

4   nearly as practicable," the particular features within Gase being relied upon by the Examiner in

5   the rejection.

6

7   The importance of the specificity requirement of 37 C.F.R. § 1.104(c) is evident in

8   M.P.E.P. § 706.07, which states:

9   The examiner should never lose sight of the fact that in every case the applicant is entitled to a full
10   and fair hearing, and that a clear issue between applicant and examiner should be developed, if
11   possible, before appeal.
12
13   A clear issue, however, cannot be developed between Appellants and the Examiner where the

14   basis for the Examiner's rejection of the claims is <u>ambiguous</u>. The Examiner's "analysis"

15   provides little insight as to (i) how the Examiner is interpreting the elements of the claims and

16   (ii) what <u>specific</u> features within Gase the Examiner believes identically discloses the <u>specific</u>

17   elements (and interactions between elements) recited in the claims. By failing to specifically

18   identify those features within Gase being relied upon in the rejection, the Examiner has

19   essentially <u>forced Appellants to engage in mind reading and/or guessing</u> to determine how the

20   Examiner is interpreting the elements of the claims and what specific features within Gase the

21   Examiner believes identically disclose the claimed invention.

22

23   As noted by the Supreme Court in <u>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki</u>

24   <u>Co.</u>,[10] a clear and complete prosecution file record is important in that "[p]rosecution history

25   estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO

---

[10] 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

1   during the application process." The Courts that are in a position to review the rejections set

2   forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit,

3   and the Supreme Court) can only review what has been written in the record; and therefore, the

4   Examiner must clearly set forth the rationale for the rejection and clearly and particularly point

5   out those elements within the applied prior art being relied upon by the Examiner in the

6   statement of the rejection.

7

8   Essentially, the Examiner is placing the burden on Appellants to establish that Gase does

9   not disclose the claimed elements based upon Appellants' interpretation of the claims and

10 Appellants' comparison of the claims with the applied prior art. However, this shifting of

11 burden, from the Examiner to Appellants, is <u>premature</u> since <u>the Examiner has not discharged the</u>

12 <u>initial burden of providing a *prima facie* case of anticipation</u>. Appellants also note that any

13 continuing disagreement between Appellants and the Examiner as to whether or not a particular

14 claimed feature is disclosed by Gase is a <u>direct result</u> of a lack of specificity by the Examiner in

15 the statement of the rejection

16

17   The above arguments were originally presented on pages 8-10 of the Response. The

18 Examiner's apparent reply to these arguments is found in the paragraph spanning pages 11 and

19 12 of the Second Office Action. Upon reviewing the Examiner's response, Appellants and the

20 Examiner have a fundamental disagreement as to what constitutes a proper rejection under 35

21 U.S.C. § 102. Appellants' position is that the Examiner (i) identify the claimed

22 elements/limitations; (ii) for each of the claimed elements/limitations provide a claim

23 construction; and (iii) for each of the claimed element/limitations, specifically identify a teaching

1 in the applied prior art that allegedly discloses the claimed element/limitation. Appellants,

2 however, recognize that if an identified teaching in the applied prior art unambiguously

3 identically corresponds to the claimed element/limitation, then a claim construction of that

4 particular claimed element/limitation is not necessary. However, where the Examiner has

5 engaged in some type of analysis (i.e., claim construction) in order to assert that a particular

6 teaching in the applied prior art identically discloses a particular claimed element/limitation, the

7 Examiner is obligated to share that analysis with Appellants.

8

9   On the other hand, based upon the analysis initially provided by the Examiner and the

10 Examiner's response to Appellants' prior arguments, the Examiner apparently believes that a

11 proper rejection under 35 U.S.C. § 102 can involve lumping together numerous claimed

12 element/limitations and citing to one or several passages in the applied prior art (i) without

13 explaining why the passages are relevant, in general, (ii) without identifying what passage is

14 relevant to a particular claimed element, and (iii) without providing any claim construction.

15 Apparently, the Examiner's position is that Appellants should review these passages and (i) guess

16 as to how the Examiner is interpreting the elements of the claims and (ii) guess as to the specific

17 features within the applied prior art that the Examiner believes identically discloses the specific

18 elements/limitations recited in the claims. Essentially, the Examiner believes the burden of

19 proving patentability over the applied prior rests with Appellants after the Examiner has set forth

20 the minimalist of rejections.

21

22   Based upon Appellants prior arguments and the law cited therein, Appellants position is

23 that the Examiner has failed meet the initial burden of establishing a prima facie case of

1   anticipation. As such, until that prima facie case has been made, Appellants have no burden to

2   point out the differences between the applied prior art and the claimed invention. Referring to

3   the unpublished opinion of <u>Ex parte Pryor</u>[11], the Board of Patent Appeals and Interferences

4   recognized the necessity for an Examiner to supply sufficient information to establish a prima

5   facie case of anticipation. Specifically, the Board wrote:

6   At the outset, we note the examiner has been of little help in particularly explaining the
7   rejections on appeal. A mere statement that claims stand rejected "as being clearly anticipated by"
8   a particular reference, without any further rationale, such as pointing out corresponding elements
9   between the instant claims and the applied reference, fails to clearly make out a <u>prima facie</u> case of
10 anticipation. (emphasis in original)
11

12   Notwithstanding that the burden of pointing out the differences between the applied prior

13 art and the claimed invention has not been shifted to Appellants, and contrary to the Examiner's

14 assertion, on pages 10-11 of the Response, Appellants presented arguments as to the differences

15 between Gase and the claimed invention.

16

17 <u>Claim 1</u>

18   On pages 10-11 of the Response, Appellants presented the following arguments.

19 Although Appellants' analysis of the Examiner's rejection has been greatly hampered by the lack

20 of specificity in the Examiner's stated analysis, Appellants refer to the following claimed

21 limitations respectively found in claims 1, 2, 7, and 11: "programmed to moderate access,"

22 "programmed to select a particular one of said application process and protocols in said list,"

23 "selecting a particular application/protocol layer in a higher one of said two layers," and "a

24 particular application/protocol layer ... is selected to receive traffic flowing through the

---

[11] Appeal No. 1997-2981.

1 hierarchy." In contrast to these limitations, reference is made to column 3, lines 46-55, which is

2 reproduced below:

> The primary application 30 listens to all incoming data packets on the contested port 34.
> When a data packet is received, the primary application 30 delivers a copy of the data packet over
> the registration port 36 to *all* secondary applications registered in the distribution list 38. The
> primary and secondary applications are then free to consume the data packets for their own
> processes. In this manner, a data packet destined for a single contested port can be conveniently
> shared among multiple applications executing on the client computer 24.

10 As evident from this passage, Gase does not teach that access has been moderated to all of the

11 application/protocols in the layered hierarchy or that a particular application/protocol has been

12 selected. Instead, Gase teaches that the primary application sends a copy of the data packet to all

13 the secondary applications (i.e., 32(1), 32(2) ... 32(N)). Thus, Gase fails to identically disclose,

14 within the meaning of 35 U.S.C. § 102, all of the claimed limitations recited in the claims.

15

16 In the paragraph spanning pages 12 and 13 of the Second Office Action, the Examiner

17 responded as follows:

> Applicant further argued that Case does not teach the claimed "moderate access" In response,
> Gate's teaching" "*The client 24 supports multiple applications that might be interested in listening
> to the same network port. Each application is configured to support a port sharing protocol that
> enables multiple applications to receive the packets being sent over the single "contested" port...
> The primary application 30 listens to all incoming data packets on the contested port 34. When a
> data packet is received, the primary application 30 delivers a copy of the data packet over the
> registration port 36 to all secondary applications registered in the distribution list 38" [see the
> discussion beginning at col.3, line 1]* reads-on the limitations as claimed. (emphasis in original)

27 The Examiner's "response" is merely to repeat what the Examiner has already stated in the

28 paragraph spanning pages 6 and 7 of the Second Office Action and in the first full paragraph on

29 page 5 of the First Office Action.

30

31 Not only has the Examiner's "response" failed to address all the issues that Appellants

32 have previously raised, the Examiner's response does not add anything new. The Examiner has

33 not specifically disclosed within the applied prior art where the Examiner believes the above

1   identified limitations are allegedly identically disclosed. Moreover, the Examiner has yet to

2   provide any claim constructions whatsoever for any of the claimed limitations. In the first full

3   paragraph on page 13 of the Second Office Action, the Examiner reproduces a "canned"

4   paragraph regarding claim construction. This paragraph is notable in that it clearly states what

5   the Examiner has not done. The Examiner has not explained the Examiner's broadest reasonable

6   interpretation of the claims consistent with Appellants' specification. The Examiner's has not

7   explicitly recognized any ambiguities or uncertainties within the claim language. The Examiner

8   has not expressly explored the scope and breadth of the claim language. The Examiner has not

9   requested, suggested, or even implied that clarification of the claim language is needed.

10

11   In conclusion, the Examiner's "Response to Arguments" found on pages 11-13 of the

12   Second Office Action, adds <u>absolutely nothing</u> to Appellants' understanding as to the Examiner's

13   rationale for rejecting claims 1-20 under 35 U.S.C. § 102 for anticipation based upon Gase.

14   Moreover, the Examiner's <u>entire</u> Second Office Action adds <u>absolutely nothing</u> to Appellants'

15   understanding as to the Examiner's rationale for rejecting claims 1-20 under 35 U.S.C. § 102 for

16   anticipation based upon Gase. Therefore, for the reasons previously presented in the Response,

17   Appellants respectfully submit that the Examiner has failed to establish a prima facie case of

18   anticipation in rejecting claim 1 under 35 U.S.C. § 102 for anticipation based upon Gase.

19

20   <u>Claim 2</u>

21   Claim 2 recites the following claim limitations:

22   a list of application process and protocols coupled to said interlayer

23   communications process at a next higher level in said hierarchy; and,

1   at least one discrimination process programmed to select a particular one

2   of said application process and protocols in said list to which to route selected

3   incoming traffic.

4

5   On page 7 of the Second Office Action, in asserting that Gase identically discloses these

6   limitations, the Examiner's entire analysis consisted of asserting "see the discussion beginning at

7   col. 3, line 1." However, upon reviewing the Examiner's citation, Appellants are unclear as to

8   what specific teachings within Gase the Examiner is relying upon to teach the claimed (i)

9   application process and protocols (ii) list, (iii) interlayer communications process, (iv)

10   application process and protocols coupled to the interlayer communications process, (v) a next

11   higher level in the, and (vi) at least one discrimination process programmed to select a particular

12   one of said application process and protocols in said list to which to route selected incoming

13   traffic. Thus, Appellants respectfully submit that the Examiner has failed to establish a prima

14   facie case of anticipation in rejecting claim 2 under 35 U.S.C. § 102 for anticipation based upon

15   Gase.

16

17   <u>Claim 3</u>

18   Claim 3 recites that "said communications layer comprises a process programmed to map

19   incoming traffic in said single logical port to selected ones of said application process and

20   protocols." On page 7 of the Second Office Action, in asserting that Gase identically discloses

21   these limitations, the Examiner's entire analysis consisted of asserting "see the discussion

22   beginning at col. 3, line 1 and col. 5, line 4." However, upon reviewing the Examiner's citations,

23   Appellants are unclear as to what specific teachings within Gase the Examiner is relying upon to

24   teach the claimed (i) communications layer (ii) a process programmed to map incoming traffic,

1   (iii) the single logical port, and (iv) selected ones. Thus, Appellants respectfully submit that the

2   Examiner has failed to establish a prima facie case of anticipation in rejecting claim 3 under 35

3   U.S.C. § 102 for anticipation based upon Gase.

4

5   <u>Claim 4</u>

6   Claim 4 recites that "said at least one discrimination process comprises at least one

7   selectable discrimination algorithm based upon at least one attribute associated with at least one

8   of said application processes and protocols." On page 8 of the Second Office Action, in

9   asserting that Gase identically discloses these limitations, the Examiner's entire analysis

10   consisted of asserting "see the discussion beginning col. 5, line 4." However, upon reviewing the

11   Examiner's citations, Appellants are unclear as to what specific teachings within Gase the

12   Examiner is relying upon to teach the claimed (i) at least one discrimination process (ii) a

13   selectable discrimination algorithm, and (iii) the algorithm is based upon at the least one attribute

14   associated with the application processes/protocols single logical port. Thus, Appellants

15   respectfully submit that the Examiner has failed to establish a prima facie case of anticipation in

16   rejecting claim 4 under 35 U.S.C. § 102 for anticipation based upon Gase.

17

18   <u>Claim 5</u>

19   Claim 5 recites the following claim limitations:

20   wherein said at least one attribute comprises an attribute selected from the group

21   consisting of a number of layers of application processes and protocols disposed

22   within said hierarchy above said interlayer communications process, a weighting

23   of said application processes and protocols in said list;

1   a catch-all to handle applications and protocols in said list which are not

2   selective in nature, previous context characteristics for said applications and

3   protocols in said list, and overall system characteristics.

4

5   On page 8 of the Second Office Action, in asserting that Gase identically discloses these

6   limitations, the Examiner's entire analysis consisted of asserting "see the discussion beginning at

7   col. 5, line 23." However, upon reviewing the Examiner's citation, Appellants are unclear as to

8   what specific teachings within Gase the Examiner is relying upon to teach the claimed (i) at least

9   one attribute, (ii) a number of layers of application processes and protocols disposed within the

10   hierarchy above said interlayer communications process, (iii) a weighting of the application

11   processes and protocols in said list, and (iv) a catch-all to handle applications and protocols in

12   the list which are not selective in nature, previous context characteristics for the applications and

13   protocols in the list, and overall system characteristics. Thus, Appellants respectfully submit that

14   the Examiner has failed to establish a prima facie case of anticipation in rejecting claim 5 under

15   35 U.S.C. § 102 for anticipation based upon Gase.

16

17   <u>Claim 6</u>

18   Claim 6 recites that "said at least one selectable discrimination algorithm comprises a

19   pluggable discrimination algorithm." On page 8 of the Second Office Action, in asserting that

20   Gase identically discloses these limitations, the Examiner's entire analysis consisted of asserting

21   "see the discussion beginning col. 5, line 23." However, upon reviewing the Examiner's

22   citations, Appellants are unclear as to what specific teachings within Gase the Examiner is

23   relying upon to teach the claimed (i) a selectable discrimination algorithm, and (ii) a pluggable

24   discrimination algorithm. Thus, Appellants respectfully submit that the Examiner has failed to

1   establish a prima facie case of anticipation in rejecting claim 6 under 35 U.S.C. § 102 for

2   anticipation based upon Gase.

3
4   Conclusion

5   Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections

6   under 35 U.S.C. §§ 101-102 and 112 is not viable. Appellants, therefore, respectfully solicit the

7   Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101-102 and 112.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: February 20, 2008

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A system for port and protocol sharing comprising:

a layered hierarchy of application processes and protocols;

an interlayer communications process disposed between each layer in said layered hierarchy; and,

a communications layer programmed to moderate access by all of said application processes and protocols in said layered hierarchy to a single logical port.

2. The system of claim 1, wherein each said interlayer communications process comprises:

a list of application process and protocols coupled to said interlayer communications process at a next higher level in said hierarchy; and,

at least one discrimination process programmed to select a particular one of said application process and protocols in said list to which to route selected incoming traffic.

3. The system of claim 1, wherein said communications layer comprises a process programmed to map incoming traffic in said single logical port to selected ones of said application process and protocols.

4. The system of claim 2, wherein said at least one discrimination process comprises at least one selectable discrimination algorithm based upon at least one attribute associated with at least one of said application processes and protocols.

5. The system of claim 4, wherein said at least one attribute comprises an attribute selected from the group consisting of a number of layers of application processes and protocols disposed within said hierarchy above said interlayer communications process, a weighting of said application processes and protocols in said list;

a catch-all to handle applications and protocols in said list which are not selective in nature, previous context characteristics for said applications and protocols in said list, and overall system characteristics.

6. The system of claim 2, wherein said at least one selectable discrimination algorithm comprises a pluggable discrimination algorithm.

7. In a hierarchy of layered applications and corresponding protocols, a port and protocol sharing method comprising the steps of:

receiving traffic over a single shared logical port and routing said traffic to an interlayer communications process disposed between two layers in the hierarchy;

selecting a particular application/protocol layer in a higher one of said two layers to which said traffic is to be routed; and,

routing said traffic to said selected particular application/protocol layer.

8. The method of claim 7, further comprising the steps of further selecting a subsequent application/protocol layer in a higher one of two other layers to which said traffic is to be routed; and,

routing said traffic to said further selected particular application/protocol layer.

9. The method of claim 7, further comprising the steps of:

adding an additional application/protocol layer to the hierarchy;

considering said additional application/protocol layer in said selecting step; and,

when selected, routing said traffic to said additional application/protocol layer.

10. The method of claim 7, wherein said selecting step comprises the step of selecting a particular application/protocol layer based upon at least one attribute of said particular application/protocol layer selected from the group consisting of a number of layers of application processes and protocols disposed within the hierarchy above said interlayer communications process, a weighting of said application processes and protocols;

a catch-all to handle individual ones of said applications and protocols which are not selective in nature, previous context characteristics for said applications and protocols, and overall system characteristics.

11. A method for augmenting a hierarchy of layered applications and corresponding protocols, the method comprising the steps of:

applying a discrimination algorithm to a selection process in which a particular application/protocol layer in a listing of adjacent application/protocol layers is selected to receive traffic flowing through the hierarchy;

inserting a new application/protocol layer adjacent to said particular application/protocol layer in the hierarchy;

adding said new application/protocol layer to said listing; and,

replacing said discrimination algorithm with another discrimination algorithm programmed to consider said new application/protocol layer during said selection process.

12. The method of claim 11, further comprising the steps of performing said inserting, adding and replacing steps without decoupling or disabling other applications and protocols in the hierarchy.

13. The method of claim 11, wherein said applying step comprises the step of applying said discrimination algorithm to select a particular application/protocol layer based upon at least one attribute of said particular application/protocol layer selected from the group consisting of a number of layers of application processes and protocols disposed within the hierarchy, a weighting of said application processes and protocols;

a catch-all to handle individual ones of said applications and protocols which are not selective in nature, previous context characteristics for said applications and protocols, and overall system characteristics.

14. A machine readable storage having stored thereon a computer program for port and protocol sharing in a hierarchy of layered applications and corresponding protocols, the computer program comprising a routine set of instructions which when executed cause the machine to perform the steps of:

receiving traffic over a single shared logical port and routing said traffic to an interlayer communications process disposed between two layers in the hierarchy;

selecting a particular application/protocol layer in a higher one of said two layers to which said traffic is to be routed; and,

routing said traffic to said selected particular application/protocol layer.

15. The machine readable storage of claim 14, further comprising the steps of further selecting a subsequent application/protocol layer in a higher one of two other layers to which said traffic is to be routed; and,

routing said traffic to said further selected particular application/protocol layer.

16. The machine readable storage of claim 14, further comprising the steps of:

adding an additional application/protocol layer to the hierarchy;

considering said additional application/protocol layer in said selecting step; and,

when selected, routing said traffic to said additional application/protocol layer.

17. The machine readable storage of claim 14, wherein said selecting step comprises the step of selecting a particular application/protocol layer based upon at least one attribute of said particular application/protocol layer selected from the group consisting of a number of layers of application processes and protocols disposed within the hierarchy above said interlayer communications process, a weighting of said application processes and protocols;

a catch-all to handle individual ones of said applications and protocols which are not selective in nature, previous context characteristics for said applications and protocols, and overall system characteristics.

18. A machine readable storage having stored thereon a computer program for augmenting a hierarchy of layered applications and corresponding protocols, the computer program comprising a routine set of instructions which when executed cause the machine to perform the steps of:

applying a discrimination algorithm to a selection process in which a particular application/protocol layer in a listing of adjacent application/protocol layers is selected to receive traffic flowing through the hierarchy;

inserting a new application/protocol layer adjacent to said particular application/protocol layer in the hierarchy;

adding said new application/protocol layer to said listing; and,

replacing said discrimination algorithm with another discrimination algorithm programmed to consider said new application/protocol layer during said selection process.

19. The machine readable storage of claim 18, further comprising the steps of performing said inserting, adding and replacing steps without decoupling or disabling other applications and protocols in the hierarchy.

20. The machine readable storage of claim 18, wherein said applying step comprises the step of applying said discrimination algorithm to select a particular application/protocol layer based upon at least one attribute of said particular application/protocol layer selected from the group consisting of a number of layers of application processes and protocols disposed within the hierarchy, a weighting of said application processes and protocols;

a catch-all to handle individual ones of said applications and protocols which are not selective in nature, previous context characteristics for said applications and protocols, and overall system characteristics.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.